APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,040	04/27/2001	James C. Hillegass	2161	1500

7590   09/30/2004

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EXAMINER
DINH, MINH

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-17_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-17_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _27 April 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892) •

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _3/29/2002._ •

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-17 have been examined.

Specification

2.   The disclosure is objected to because of the following informalities: there is no

serial number provided for the application for patent referred to in the specification (p.

11, line 13); and "FIG. 8" (specification, p. 22, line 16) should be changed to "FIG. 12".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless —
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-5 and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated

by O'Mahony et al. (Electronic Payment Systems).

a.   Regarding claims 1-3, O'Mahony discloses a digital token stored on a user's

computer, the digital token comprising a token identifier, a user identifier, a vendor

identifier and the monetary value of the token (p. 198, fig. 7.5).

b.   Regarding claim 4, O'Mahony discloses a method comprising:

receiving a data transmission comprising a credit card number, a monetary

amount and a unique previously-assigned identifier (p. 194, see Selling Vendor Scrip; p.

195, fig. 7.2; p. 198, see Cust_ID#);

assigning a unique token identifier and storing said token identifier in association

with said user identifier and said amount (p. 194, see Selling Vendor Scrip; p. 198, fig.

7.5); and

transmitting to the user who is associated with said identifier a digital token

including the token identifier and the user identifier (p. 193, fig. 7.1).

c.   Regarding claim 5, O'Mahony further discloses storing a customer secret, which

meets the limitation of a password (p. 203, fig. 7.8).

d.   Regarding claim 10, O'Mahony discloses a method comprising:

receiving via data connection a data transmission requesting application of a

token balance toward payment for a purchase, said data transmission including a token

identifier and a user identifier (p. 209, Section 7.2.3; p. 210, Section 7.2.5); and

subtracting the purchase price from the token balance and storing the updated

token balance in association with the token identifier (p. 209, Section 7.2.3; p. 210,

Section 7.2.5).

e.   Regarding claim 11, O'Mahony further discloses transmitting via data connection

to the user the updated token balance (p. 210, Section 7.2.5).

f.   Regarding claim 12, O'Mahony discloses a method comprising:

providing a server computer networked for data transmission with multiple users,

said server running software for dispensing digital licenses and software for dispensing

digital tokens and said server housing a database (p. 192, "One can envisage network users ... daily newspapers, and so forth"; p. 210, Section 7.2.4);

storing the user identifier in said database (p. 209, Section 7.2.3);

making a digital license available for purchase (p. 192, "One can envisage network users ... daily newspapers, and so forth");

transmitting a digital token to a user, said token including a token identifier (p. 209-210, figures 7.14 and 7.15);

storing in said database said token identifier in association with the user identifier and a monetary value for the token (p. 209, Section 7.2.3; p. 210, Section 7.2.4);

receiving a request via data transmission from a user to purchase a digital license, said user request including a user identifier and a token identifier (p. 209, Section 7.2.3; p. 210-211, Section 7.2.5, A Subscrip purchase);

upon request received via data transmission from a user to purchase a digital license, applying the value of the token against the purchase price of the product (p. 210-211, Section 7.2.5, A Subscrip purchase);

subtracting the purchase price from the token value and storing the updated token balance in said database (p. 210-211, Section 7.2.5, A Subscrip purchase);

transmitting the license to the user (p. 210-211, Section 7.2.5, A Subscrip purchase).

O'Mahony does not disclose assigning to a user a user identifier. However, Examiner takes Official Notice that assigning to a user a user identifier at a new account setup is common in the art. It would have been obvious to one of ordinary skill in the art

at the time the invention was made to assign to a user a user identifier when a new account is setup since Examiner takes Official Notice that assigning to a user a user identifier at a new account setup is common in the art is common in the art.

g.   Regarding claim 13, O'Mahony further discloses, upon receipt of a user request to purchase a digital license with a previously purchased digital token, comparing the user identifier and the token identifier in the request with data stored in the database to determine whether the token identifier is stored in association with the same user identifier (p. 209, Section 7.2.3, Providing anonymity; p. 211, fig. 7.16).

h.   Regarding claim 14, O'Mahony further discloses, upon receipt of a user request to purchase a digital license with a previously purchased digital token, comparing the balance stored in the database in association with the token identifier to determine whether the token represents a value at least as great as the purchase price of the digital license requested. (p. 210, Section 7.2.5, A Subscrip purchase).

i.   Regarding claim 15, O'Mahony discloses a system comprising:

a server computer running software for dispensing digital tokens, said server being connected to multiple user computers for data transmission therebetween (p. 209, fig. 7.14);

data storage housing a database connected with said software, said database including token records, each token record including a token identifier and a user identifier (p. 209, Section 7.2.3, Providing anonymity; p. 210, Section 7.2.4, A Subscrip ticket).

j.   Regarding claim 16, O'Mahony discloses a method comprising:

receiving via data transmission to a computing device a user identifier (p. 194,

Selling Vendor Scrip);

storing said user identifier on said computing device (p. 194, Selling Vendor

Scrip);

sending a data transmission requesting a digital token, said request including the

user identifier and a monetary value for the token (p. 195, fig. 7.2);

receiving via data transmission a digital token, said token including a token

identifier and said user identifier (p. 195, fig. 7.2; p. 198, fig. 7.5); and

storing said token on said computing device (p. 195, fig. 7.2).

O'Mahony does not disclose receiving via data transmission to a computing

device a user identifier and storing said user identifier on said computing device.

However, Examiner takes Official Notice that a user being assigned an identifier when a

new account is setup or opened is common in the art. It would have been obvious to

one of ordinary skill in the art at the time the invention was made to assign an identifier

to a user when a new account is setup or opened since Examiner takes Official Notice

that a user being assigned an identifier when a new account is setup or opened is

common in the art. Accordingly, the user identifier is received and stored at the user's

computer.

k.   Regarding claim 17, O'Mahony discloses a method comprising:

from a computer on which is stored a previously-purchased digital token

containing a token identifier and on which is stored a previously-assigned user identifier,

transmitting a request to make a purchase, said request including said token identifier

and said user identifier and a monetary amount for the purchase (p. 196, fig. 7.4; p. 198,

fig. 7.5); and

receiving via data transmission an updated monetary value represented by the

token having been lessened by the purchase amount (p. 196, fig. 7.4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Mahony in view of Strong (6,167,523).

a. Regarding claim 6, O'Mahony discloses a method comprising:

purchasing a digital token from a token distributor (p. 193, fig. 7.1);

receiving a digital transmission from the distributor including said token (p. 193,

fig. 7.1); and

installing said token on a computer (p. 193, fig. 7.1).

O'Mahony does not disclose using the computer registry. Strong discloses using

a computer registry for secure information storage (col. 5, lines 13-22). It would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

O'Mahony method to use a computer registry. It is more secure to store information in the registry than in a standard file.

b.   Regarding claims 7-9, O'Mahony further discloses that the token includes a token identifier, a user identifier and the monetary balance available to be spent (p. 198, fig. 7.5).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ling (US 2002/0002538 A1) discloses a method and apparatus for conducting electronic commerce transactions using electronic tokens.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
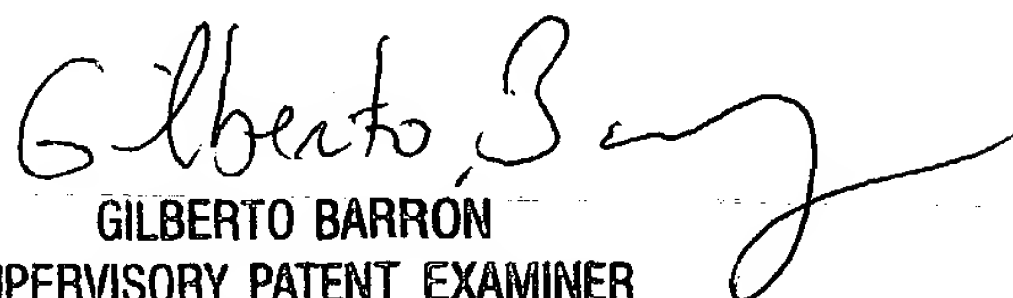
Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132

MD
9/27/04

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